



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08-587,117 01/19/96 FLOWN C 12748-00002

02M1/1125

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EXAMINER

WEAVER, S

ART UNIT

PAPER NUMBER

3207

3

DATE MAILED:

11/25/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-21 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-21 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Since the invention is directed to a nursing bottle with an air venting structure, it is suggested that the title be amended to reflect the same.

2. The abstract of the disclosure is objected to because it appears to be inaccurate in that the vent tube projects downwardly into the upper portion of the reservoir tube, not the "vent" tube as stated at line 12. Correction is required. See MPEP § 608.01(b).

3. The drawings are objected to because reference numeral "618" appears to have been used to identify two different parts in Figures 12 and 15. Moreover, there doesn't appear to be any lead line for reference numeral "730" in Figure 18. Correction is required.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. **Correction of Informalities** -- 37 CFR 1.85; 1097 O.G. 36

New formal drawings must be filed with the changes incorporated therein. The art unit number, application number (including series code) and number of drawing sheets should be written on the reverse side of the drawings. Applicant may delay filing of the new drawings until receipt of the "Notice of Allowability" (PTO-37). If delayed, the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for response in the "Notice of Allowability" (PTO-37) to avoid extension of time fees. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a) for filing the corrected drawings (but not for payment of the issue fee). The drawings should be filed

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as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the three month shortened statutory period set in the "Notice of Allowability" (PTO-37). Within that three month period, two weeks should be allowed for review of the new drawings by the Office. If a correction is determined to be unacceptable by the Office, applicant must arrange to have an acceptable correction re-submitted within the original three month period to avoid the necessity of obtaining an extension of time with extension fees. Therefore, applicant should file corrected drawings as soon as possible.

Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

4. The disclosure is objected to because of the following informalities: It appears that many features identified in the drawings with reference numerals "21¹", "222", "236", "237", "240", "250", "23", "310", "312", "321", "322", "325", "340", "350", "440" and "450", for example, have not been described in the specification.

Appropriate correction is required.

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5. Claims 3-6, 9-12, 13-18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It isn't clear how claims 3 and 9 are considered to further limit the invention as claimed in claims 1 and 7. If the liquid conduit has "a volume less than that of the reservoir" as claimed in claims 1 and 7, won't the volume of the reservoir have to be "greater than the volume of the liquid conduit", as claimed in claims 3 and 9?

The vent tube in claim 14 appears to be a double inclusion of the "airway" claimed in claim 13.

Moreover, the "insert" while not having any particular structure, also doesn't appear to have any function in claim 15, rendering the claims vague and indefinite.

The expression "an open second end projecting sufficiently downwardly into the container (receptacle)"^{is} considered to render claims 13 and 19 vague and indefinite, as applicants have not claimed what it is sufficient for, "Sufficiently" for what?

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10 of prior U.S. Patent No. 5,570,796. This is a double patenting rejection.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunkerley.

Note the embodiment in Figure 6 which is considered to inherently provide a reservoir tube with the vent tube at c providing an airway between the outside of the container with an inner end which opens into the reservoir tube at D, which, when the fluid level gets low enough, will be above the fluid level when the container is inverted, as claimed.

8. Claims 1-12 are directed to the same invention as that of claims 1-10 of commonly assigned 5,570,796. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

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Since the Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

9. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by claims 1-10 of U.S. Patent 5,570,796 to Brown et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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10. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-10 of U.S. Patent No. 5,570,796 in view of Dunkerley. Claims 6-10 call for a reservoir and a liquid conduit which extends from a point near the bottom of the container. However to have made such structure where the reservoir and liquid conduit are all one section and the tube doesn't extend near the bottom would have been obvious in view of Dunkerley. To have made the device removable from the container and used it on another type of container would also have been obvious in view of Dunkerley. To have further provided an "insert " would have been obvious in view of Dunkerley.

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents cited in the patent application have been considered and are hereby made of record. The additional patents
SW show other vent units.

Any inquiry concerning this communication should be directed to Examiner Weaver at telephone number (703) 308-1148.

Weaver/tnt

November 19, 1996

Sue A. Weaver

**SUE A. WEAVER
PRIMARY EXAMINER
GROUP 3200**